



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/583,943	05/31/2000	Michael Wayne Brown	AUS000047US1	4372

7590 01/30/2004

BRACEWELL & PATTERSON ,LLP  
INTELLECTUAL PROPERTY LAW  
P.O. BOX 969  
AUSTIN, TX 78767-0969

EXAMINER
----------

PASS, NATALIE

ART UNIT	PAPER NUMBER
----------	--------------

3626

DATE MAILED: 01/30/2004

10

Please find below and/or attached an Office communication concerning this application or proceeding.



UNITED STATES PATENT AND TRADEMARK OFFICE

Commissioner for Patents  
United States Patent and Trademark Office  
P.O. Box 1450  
Alexandria, VA 22313-1450  
[www.uspto.gov](http://www.uspto.gov)

**BEFORE THE BOARD OF PATENT APPEALS  
AND INTERFERENCES**

Paper No. 10

Application Number: 09/583,943  
Filing Date: May 31, 2000  
Appellant(s): BROWN ET AL.

\_\_\_\_\_  
Craig Yudell  
For Appellant

MAILED

JAN 30 2004

GROUP 3600

**EXAMINER'S ANSWER**

This is in response to the appeal brief filed 06 November 2003.

**(1) *Real Party in Interest***

A statement identifying the real party in interest is contained in the brief.

**(2) *Related Appeals and Interferences***

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

**(3) *Status of Claims***

The statement of the status of the claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

This appeal involves claims 1-9 and 11-66.

**(4) *Status of Amendments After Final***

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

**(5) *Summary of Invention***

The summary of invention contained in the brief is correct.

**(6) *Issues***

The appellant's statement of the issues in the brief is correct.

Art Unit: 3626

**(7) Grouping of Claims**

Appellant's brief includes a statement that claims 1-39 stand or fall together and claims 40-66 stand or fall together and provides reasons as set forth in 37 CFR 1.192(c)(7) and (c)(8). However, claim 10 has been cancelled and is no longer pending. A correct statement of the grouping of the claims is as follows:

- I. Claims 1-9 and 11-39 stand or fall together, and
- II. Claims 40-66 stand or fall together.

**(8) Claims Appealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

**(9) Prior Art of Record**

- 5,778,882 Raymond et al. 07-1998
- 5,980,447 Trudeau, Guy J 11-1999
- 5, 542, 420 Goldman 08-1996
- 5,890,128 Diaz et al. 03-1999
- Gulf Goans' Mailing List Newsletter, GOA-WORLD - WEEKEND POST  
NEWSLETTER - VOLUME XIII - 25 NOVEMBER 1998, <[http://www.goa-world.net/gulf\\_goans/nov31.htm](http://www.goa-world.net/gulf_goans/nov31.htm)>
- Notes.Net Filtering Article, 1999, <[http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/\\$FILE/mailrule.pdf](http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/$FILE/mailrule.pdf)>

**(10) Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1-9 and 11-66 are rejected under 35 U.S.C. 103(a). This rejection is set forth in prior Office Actions, Papers No. 3 and 5 and reproduced hereinbelow. The rejections which appear below substantially repeat the rejections made in the previous Office Actions (Papers No. 3 and 5). The text of those sections of Title 35 U.S. Code relied upon in the Examiner's Answer is set forth in the previous Office actions, Papers No. 3 and 5.

***Claim Rejections - 35 USC § 103***

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-4, 11-12, 14-17, 23-25, 27-30, 36-38, 40-66 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 in view of Trudeau et al, U.S. Patent Number 5, 980, 447.

(A) As per claim 1, Raymond teaches a method, a system, and a program for prioritizing actions in order to balance the comprehensive health of a user, said method comprising the steps of:

Art Unit: 3626

automatically monitoring current health parameters for a particular user at a personal health monitoring system, wherein said current health parameters includes a plurality of monitored physical parameters and a plurality of monitored environmental parameters (Raymond; see at least Figures 17, 18, 19, 19A, column 1, lines 42 to column 2, line 60, column 5, lines 30-44, column 28, lines 37-49).

Raymond fails to explicitly disclose

receiving a plurality of actions for selection by said particular user at said personal health monitoring system;

prioritizing said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system;

presenting the prioritized plurality of actions for selection by said particular user, such that said personal health monitoring system, aids said particular user in selecting from among said plurality of actions in order to balance the comprehensive health of said particular user; and

determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowance.

Trudeau teaches

receiving a plurality of actions for selection by said particular user at said personal health monitoring system (Trudeau; column 5, lines 16-21, column 9, lines 20-41);

Art Unit: 3626

prioritizing or ranking said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system (Trudeau; column 5, lines 21-26, column 10, line 50-61);

presenting the prioritized plurality of actions for selection by said particular user, such that said personal health monitoring system, aids said particular user in selecting from among said plurality of actions in order to balance the comprehensive health of said particular user (Trudeau; Figure 1, Items 10, 12, Figure 2, Item 22, Figure 3, Item 37, column 5, lines 13-26, column 6, lines 50-64, column 9, lines 5-15, column 9, line 66 to column 10, line 35, column 10, line 50-61, column 16, line 64 to column 17, line 5); and

determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, lines 4-46).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond to include receiving a plurality of actions for selection by said particular user at said personal health monitoring system; prioritizing or ranking said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system, presenting the prioritized plurality of actions for selection by said particular user, such that said personal health monitoring system, aids said particular user in selecting from among said plurality of actions in order to

Art Unit: 3626

balance the comprehensive health of said particular user; and determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances, as taught by Trudeau, with the motivation of ranking in frequency and duration of use, as well as timing and scheduling, the mastering of personal health or recovery tools as well as the tracking and recording of a subject's progress in achieving balanced personal health or recovery, of establishing obtainable goals and during that process, providing both quantitatively and qualitatively measurable progress, and of generating a change environment for balanced personal health or recovery by including interaction between the user and the process utilizing user defined profiles through test results and the incorporation of options and selections into the system (Trudeau; column 4, lines 26-44).

(B) Claim 14 differs from method claim 1, in that it is a system rather than a method for prioritizing actions in order to balance the comprehensive health of a user.

System claims 14 repeats the subject matter of claim 1, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 1 have been shown to be fully disclosed by the collective teachings of Raymond and Trudeau in the above rejection of claim 1, it is readily apparent that the system disclosed collectively by Raymond and Trudeau includes the apparatus to perform these functions. As such, these limitations are rejected for the same reasons given above for method claim 1, and incorporated herein.



(C) Claim 27 differs from method claim 1 by reciting a “computer readable medium having computer readable program code means...” in the preamble. As per this limitation, Raymond clearly discloses his invention to be implemented on a “computer readable medium having computer readable program code means (Raymond; col. 2, line 60 to column 3, line 35). The remainder of claim 27 repeats the limitations of claim 1, and is therefore rejected for the same reasons given above for claim 1.

The motivations for combining the respective teachings of Raymond and Trudeau are as given in the rejection of claim 1 above, and incorporated herein.

(D) As per claims 2-4, 15-17, 28-30, Raymond and Trudeau teach a method, a system and a program discussed in claims 1, 14, and 27 above, said step, system, and means of monitoring current health parameters for a particular user at said personal health monitoring system further comprising the step, system, and means of monitoring medication intake (Raymond; Figure 19, column 3, lines 47-57, column 5, lines 30-43, column 25, line 62 to column 26, line 11) and food and liquid intake (Raymond; column 5, lines 38-43) by said particular user and monitoring environmental exposure of said particular user (Raymond; column 5, lines 38-43, column 6, lines 33-46, column 8, lines 25-29).

(E) As per claims 11, 23-24, 36-37, Raymond and Trudeau teach a method, a system and a program discussed in claims 1, 14, and 27 above, said step, system, and means of prioritizing said plurality of actions according to said current health parameters and designated

Art Unit: 3626

allowances for said particular user at said personal health monitoring system, further comprising the steps, system, and means of determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowance from among time allowances, financial allowances, and health allowances (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, lines 4-46), and determining whether each of said plurality of selectable actions are allowed according to a plurality of conditional requirements for allowance of said plurality of selectable actions (Trudeau; column 5, lines 4-60, column 6, lines 55-64, column 11, lines 34-63, column 12, lines 7-44).

(F) As per claims 12, 25, and 38, Raymond and Trudeau teach a method, a system and a program discussed in claims 1, 14, 27, said method, system and program further comprising the steps, system, and means of transmitting said plurality of actions, said health profile and said designated allowances to an alternate decision making system and receiving a prioritization of said plurality of actions from said alternate decision making system at said personal health monitoring system (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, line 4 to column 13, line 21).

(G) Claim 40 differs from claims 1, 14, and 27 in that it is a method for scheduling tasks in order to balance the comprehensive health of a user, rather than a method, system or program for prioritizing actions in order to balance the comprehensive health of a user.

Art Unit: 3626

As per claim 40, Raymond teaches a method for scheduling tasks in order to balance the comprehensive health of a user, said method comprising the steps of:

monitoring current health parameters for a particular user at a personal health monitoring system, wherein said current health parameters includes a plurality of monitored physical parameters and a plurality of monitored environmental parameters (Raymond; see at least Figures 17, 18, 19, 19A, column 1, lines 42-67, column 2, lines 46-52);

Raymond fails to explicitly disclose

receiving a plurality of tasks for said particular user for scheduling at said personal health monitoring system; and

selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user.

Trudeau teaches receiving a plurality of tasks for said particular user for scheduling at said personal health monitoring system (Trudeau; column 5, lines 16-21, column 9, lines 20-41); and

selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user (Trudeau; column 5, lines 21-26, column 10, line 50-61).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond to include receiving a plurality of tasks for said particular user for scheduling at said personal health monitoring system; and selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user, as taught by Trudeau, with the motivation of ranking in frequency and duration of use, as well as timing and scheduling, the mastering of personal health or recovery tools as well as the tracking and recording of a subject's progress in achieving balanced personal health or recovery, of establishing obtainable goals and during that process, providing both quantitatively and qualitatively measurable progress, and of generating a change environment for balanced personal health or recovery by including interaction between the user and the process utilizing user defined profiles through test results and the incorporation of options and selections into the system (Trudeau; column 4, lines 26-44).

(H) System claim 49 repeats the subject matter of claim 40, respectively, as a set of “means-plus-function” elements rather than a series of steps. As the underlying processes of claim 40 have been shown to be fully disclosed by the collective teachings of Raymond and Trudeau in the above rejections of claim 40, it is readily apparent that the system disclosed collectively by Raymond and Trudeau includes the apparatus to perform these functions. As

Art Unit: 3626

such, these limitations are rejected of the same reasons given above for method claim 40, and incorporated herein.

(I) Claim 58 differs from method claim 1 by reciting "a program ...[...] residing on a computer readable medium having computer readable program code means..." in the preamble. As per this limitation, Raymond clearly discloses his invention to be implemented on a "computer readable medium having computer readable program code means (Raymond; col. 2, line 60 to column 3, line 35). The remainder of claim 58 repeats the limitations of claim 40, and is therefore rejected for the same reasons given above for claim 40.

The motivations for combining the respective teachings of Raymond and Trudeau are as given in the rejection of claim 40 above, and incorporated herein.

(J) As per claims 41, 50, 59, Raymond and Trudeau teach a method, a system, and a program as discussed in claims 40, 49, and 58 above, further comprising receiving said plurality of tasks with a priority assigned to each of said plurality of tasks (Trudeau; column 5, lines 16-21, column 9, lines 20-41); and

selecting suitable times for scheduling said plurality of tasks according to said priority assigned to each of said plurality of tasks and a priority assigned to each task already scheduled (Trudeau; column 5, lines 21-26, column 10, line 50-61).

(K) As per claims 42-44, 51-53, and 60-62, Raymond and Trudeau teach a method, a system, and a program as discussed in claims 40, 49, and 58 above, further comprising receiving

Art Unit: 3626

said plurality of tasks for said particular user from an alternate decision making system (Trudeau; column 5, lines 13-55, column 6, lines 55-64, column 11, lines 47-63, column 12, line 4 to column 13, line 21), and internally determining said plurality of tasks for said particular user at said personal health monitoring system according to said current health parameters and said designated allowances (Trudeau, column 5, lines 28-42) and receiving said plurality of tasks from said particular user via an input interface coupled to said personal health monitoring system (Trudeau, column 5, lines 43-60, column 7, lines 13-30).

(L) As per claims 45, 54, and 63, Raymond and Trudeau teach a method, a system, and a program as discussed in claims 40, 49, and 58 above, further comprising the steps of:

determining whether a particular task from among said plurality of tasks is schedulable (Trudeau; column 12, line 55 to column 13, line 14, column 13, lines 30-48); and

prompting said particular user to determine whether or not to schedule said particular task, in response to determining that said particular task is not schedulable (Trudeau; column 13, line 49 to column 14, line 9).

(M) As per claims 46-48, 55-57, and 64-66, Raymond and Trudeau teach a method, a system, and a program as discussed in claims 40, 49, and 58 above, further comprising the steps of:

determining whether each of said plurality of tasks is allowable according to designated conditional time requirements at said personal health monitoring system (Trudeau; column 12, line 55- to column 13, lines 14, column 13, lines 30-48), and scheduling tasks in an electronic

Art Unit: 3626

schedule according to time allowances designated by said particular user (Trudeau; column 12, line 55 to column 13, line 14, column 13, line 30 to column 14, line 9), and indicating whether a scheduled task requires verification of performance (Trudeau; column 14, lines 6-7).

3. Claims 5-7, 18-20, 31-33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Goldman et al, U.S. Patent Number 5, 542, 420.

(A) As per claims 5-6, 18-19, 31-32, Raymond and Trudeau teach a method, a system, and a program discussed above, in claims 1, 14, and 27.

Raymond and Trudeau fail to explicitly disclose said step, system, and means of monitoring current health parameters for a particular user at said personal health monitoring system further comprising the step, system, and means of monitoring exercise performed by said particular user, and monitoring bodily health indicators for said particular user.

Goldman teaches the step, system, and means of monitoring exercise performed by said particular user (Goldman; column 9, lines 17-21, column 11, lines 20-35, column 16, lines 1-27), and monitoring bodily health indicators for said particular user (Goldman; column 11, lines 15-42, column 12, lines 9-11, column 16, lines 1-27).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond and Trudeau to include further comprising the

Art Unit: 3626

step, system, and means of monitoring exercise performed by said particular user, and monitoring bodily health indicators for said particular user, as taught by Goldman, with the motivation of integrating the technological capabilities of current communication and data processing techniques with accumulation and storage of medical and health-related knowledge relating to individuals, of accumulating, storing, analyzing and processing health-related data for individuals (profiles) as a basis for specifying personalized prescriptions which may improve the health and welfare of healthy individuals, as well as persons suffering from various diseases or disorders, and of defining more precise personal needs that take into consideration demographic characteristics, eating habits, personal health, health history, family history, work, physical activity and so on (Goldman; column 2, lines 21-25, column 3, lines 27-31, lines 51-60).

(B) As per claims 7, 20, and 33, Raymond, Trudeau and Goldman teach a method, a system and a program discussed above, in claims 1, 14, 27, said step, system, and means of receiving a plurality of actions for selection by said particular user at said personal health monitoring system further comprising the step, system, and means of receiving a plurality of selectable medication orders at said personal health monitoring system from a physician accessible server system (Raymond; column 27, lines 10-15, 37-42, 53-59), (Goldman; Figure 7, column 3, line 62 to column 4, line 34, column 8, lines 63-65, column 17, lines 44-60).

4. Claims 8, 21, and 34 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980,



Art Unit: 3626

447 as applied to claims 1, 14, and 27 above, and further in view of Diaz et al, U.S. Patent Number 5, 890, 128.

(A) As per claims 8, 21, and 34, Raymond and Trudeau teach a method, a system, and a program discussed above, in claims 1, 14, and 27.

Raymond and Trudeau fail to explicitly disclose said step, system, and means of receiving a plurality of actions for selection by said particular user at said personal health monitoring system, further comprising the step, system, and means of receiving a plurality of selectable food menu items at said personal health monitoring system from a restaurant menu server.

Diaz teaches said step, system, and means of receiving a plurality of selectable food menu items at said personal health monitoring system from a restaurant menu server (Diaz; Figure 2, Item 104, column 3, lines 39-67, column 4, lines 39-67, column 15, lines 5-8, column 25, line 56 to column 26, line 20)

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond and Trudeau to include said step, system, and means of receiving a plurality of actions for selection by said particular user at said personal health monitoring system, further comprising the step, system, and means of receiving a plurality of selectable food menu items at said personal health monitoring system from a restaurant menu server, as taught by Diaz, with the motivation of providing a user with a confidential, convenient, interactive, easy to use, method of accessing real time comprehensive caloric/fat targets and

Art Unit: 3626

historical data directly tied to the individual's physical characteristics, metabolism, way of life, physical activities, and eating habits. This comprehensive information in turn allows the user to make conscious well informed health changes related to physical activities and dietary routine as often as desired to increase, decrease or maintain body weight (Diaz; column 5, lines 40-50).

5. Claims 9, 22, and 35 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Gulf Goans' Mailing List Newsletter, GOA-WORLD - WEEKEND POST NEWSLETTER - VOLUME XIII - 25 NOVEMBER 1998, <[http://www.goa-world.net/gulf\\_goans/nov31.htm](http://www.goa-world.net/gulf_goans/nov31.htm)>, hereinafter known as Goans Listserv.

(A) As per claims 9, 22, and 35, Raymond and Trudeau teach a method, a system, and a program discussed above, in claims 1, 14, and 27.

Raymond and Trudeau fail to explicitly disclose said step, system, and means of receiving a plurality of actions for selection by said particular user at said personal health monitoring system, further comprising the step, system, and means of receiving a plurality of selectable electronic recipes at said personal health monitoring system from an electronic recipe server.

Goans Listserv teaches the step of receiving a plurality of selectable electronic recipes at said personal health monitoring system from an electronic recipe server (Goans Listserv; pages 4-5).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond and Trudeau to include said step of receiving a plurality of actions for selection by said particular user at said personal health monitoring system, further comprising the step of receiving a plurality of selectable electronic recipes at said personal health monitoring system from an electronic recipe server, as taught by Goans Listserv, with the motivation of integrating the technological capabilities of current communication and data processing techniques, including interaction between the user and the process, and providing a user with a confidential, convenient, interactive, easy to use, method of accessing real time comprehensive food preparation information directly tied to the individual's way of life, and eating goals. This comprehensive information in turn allows the user to make conscious well-informed health changes related to dietary routine.

6. Claims 13, 26, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Raymond et al, U.S. Patent Number 5, 778, 882 and Trudeau et al, U.S. Patent Number 5, 980, 447 as applied to claims 1, 14, and 27 above, and further in view of Notes.Net Filtering Article, 1999, < [http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/\\$FILE/mailrule.pdf](http://www-10.lotus.com/ldd/today.nsf/62f62847467a8f78052568a80055b380/4541559cb15c46e285256815007b107d/$FILE/mailrule.pdf)>, hereinafter known as Filtering Article.

(A) As per claims 13, 26, and 39, Raymond and Trudeau teach a method, a system, and a program discussed above, in claims 1, 14, and 27.

Raymond and Trudeau fail to explicitly disclose said method, system and program further comprising the step, system, and means of filtering said plurality of actions according to electronic preferences designated by said particular user at said personal health monitoring system.

Filtering Article teaches filtering said plurality of actions and incoming information according to electronic preferences designated by said particular user at said personal health monitoring system (Filtering Article; see entire article, especially page 3, lines 11-15).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the method, system, and program for prioritizing actions in order to balance the comprehensive health of a user of Raymond and Trudeau to include further comprising the step of filtering using filtering rules said plurality of actions according to electronic preferences designated by said particular user at said personal health monitoring system, as taught by Mail Filtering article, with the motivation of reducing the number of, or sorting, or eliminating those actions that are less important or not relevant from the plurality of actions received, and doing so according to user preferences, thus personalizing the plurality of actions received according to such variables as sender, subject, importance, and priority (Filtering Article; see entire article, especially pages 5-6).

**(11) *Response to Argument***

In the Appeal Brief filed 06 November 2003, Appellant makes the following argument:

- (A) The applied references do not show or suggest limitations in claims 1-9, 11-39.
- (B) The applied references do not show or suggest limitations in claims 40-66.

Examiner will address Appellant's arguments in sequence as they appear in the brief.

*1. Group I:*

(A) In response to Appellant's assertion that Raymond in view of Trudeau, do not show or suggest limitations in claims 1-9 and 11-39 of Appellant's invention, all of the limitations which Appellant disputes are missing in the applied references, including prioritizing or ranking said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system and determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Raymond and Trudeau, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 3 and 5), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

In particular, Examiner notes Raymond and Trudeau teach all the limitations of claim 1, including the steps of "prioritizing or ranking said plurality of actions according to said current

health parameters and designated allowances for said particular user at said personal health monitoring system" and of "determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances" and further "wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances."

As regards Appellant's arguments concerning these limitations, it should be noted that Examiner is giving the claim limitations their broadest reasonable interpretation. In particular, the word "allowances" is being interpreted as "that which is allowed" (as given by Appellant in the dictionary definition provided in the paragraph bridging pages 4 and 5 of the Appeal Brief) or, in other words, as that which, in order to be allowable, fits within a set of minimum / maximum constraints, as described in Appellant's discussion of time allowances in the specification (for example page 22, Table 1 , and explanation on page 23, paragraph 2) and in Appellant's discussion of financial allowances (for example page 27, paragraph 1 in the specification). Further, to the extent that Examiner understands the present specification, "designated allowances" can include minimum/maximum recommendations or "budgeting" limits as to what is allowable, whether selected or designated by the user or whether put forth in a strategy of action by a system recommending or proposing specific procedures to modify a program to be followed by the user (see page 23, paragraph 2 and page 27, paragraph 1 of instant specification).

It is further noted, insofar as Appellant recites "at least one type of allowance from among time allowances, financial allowances, and health allowances," it is immaterial as to whether the applied prior art necessarily includes all three types of allowances.

Furthermore, it is respectfully noted by the Examiner that the reference that is most disputed by Appellant is the Trudeau reference, which was the secondary reference in the Examiner's rejections. Appellant's insistence of viewing the Trudeau reference separately and apparently in a vacuum is seen as nothing more than a piecemeal analysis of the applied reference with out properly considering the teaching of Raymond and Trudeau collectively as a whole.

In this regard, Examiner respectfully notes that stated objectives of Trudeau's invention include "to rank in frequency and duration of use, as well as timing and scheduling, the mastering of recovery tools as well as the tracking and recording of a subject's progress in recovery ... to establish obtainable goals of recovery well within a [designated time] period [...] and during that process, provide both quantitatively and qualitatively measurable progress" (Trudeau; column 4, lines 26-32).

Note, for example, that within this framework Trudeau teaches "interactively testing and evaluating a user's mental condition and recommending specific procedures ... depending upon the results of the test...[and] ... a specific program for the user to follow to further the user's progress in the recovery process" as well as "recommending to the user a specific action to be taken in order to moderate the level of distress indicated by the results." In addition to "structuring a specific program for the user to follow to further the user's progress in the recovery process," Trudeau's system "custom configure[s] the recovery program for each individual" and "modifies the program to be followed by the user by introducing new processes and methods into the program thereby activating certain operative principles which by their very nature generate certain results for the user and thereby reinforce the incorporation of the new processes and

Art Unit: 3626

methods under use" (Trudeau; column 5, lines 4-60, column 6, lines 40-64, column 7, lines 1-11). The system described above, which includes recommendations to a user for specific programs to follow to aid in recovery of health, as taught by Trudeau, reads on "prioritizing or ranking said plurality of actions according to said current health parameters and designated allowances for said particular user at said personal health monitoring system" and on "determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances" and further "wherein said designated allowances includes at least one type of allowances from among time allowances, financial allowances, and health allowances," more specifically reading on health allowances.

Further, in Trudeau's invention the computer establishes a user profile and responds to the user profile of the particular user at the particular time by proposing to the user a strategy of action from a list of possible actions appropriate for the user's profile (Trudeau; column 5, lines 43-60, column 9, lines 5-41). Trudeau's system compiles recommendations from the user's profiles and other baseline data and incorporates an "expert system to recommend certain remedial actions in response to these parameters" (Trudeau; column 10, lines 50-65). These actions include direction of the user to tools or actions most capable of lowering distress or altering the health problem or fitting within designated allowances and include other recommendations depending upon the nature of the crisis. The system "ranks the available tools in a simple progression of stress reducing actions" (Trudeau; column 10, lines 50-65). Examiner notes that an expert system that recommends actions based on specific parameters includes the determination of a priority level at which sufficient allowances are available for each of the potential actions in order to make the recommendation. Consequently, the Examiner respectfully



Art Unit: 3626

submits that determining a priority level at which sufficient allowances are available for each of said plurality of actions in view of said designated allowances, wherein said designated allowances includes at least one type of allowance from among time allowances, financial allowances, and health allowances is taught by the applied references.

As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to Appellant's assertion on page 5, last line of the Appeal Brief, which Trudeau's invention does not teach "a user profile contains such allowances for the user" this feature is not part of the claimed invention.

In response to Appellant's assertion on page 6, line 31 of the Appeal Brief, that the Examiner's conclusion of obviousness is based upon improper hindsight reasoning, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the Appellant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

2. *Group II:*

In response to Appellant's assertion that Raymond in view of Trudeau, do not show or suggest limitations in claims 40-66 of Appellant's invention, all of the limitations which Appellant disputes are missing in the applied references, including selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user, have been fully addressed by the Examiner as either being fully disclosed or obvious in view of the combined teachings of Raymond and Trudeau, based on the logic and sound scientific reasoning of one ordinarily skilled in the art at the time of the invention, as detailed in the 35 USC § 103 rejections given in the cited sections of the prior Office Actions (papers number 3 and 5), and as noted above, and incorporated herein. Further reasons appear hereinbelow.

In particular, Examiner notes that the limitation of "selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated

Art Unit: 3626

allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user" are indeed taught by the combination of cited references. In particular, Trudeau's system assists in selecting suitable times for scheduling the mastering of recovery tools or tasks in view of current health parameters, including scheduling options for meetings, workshops and suggested personal therapy tasks (Trudeau; Figure 7, Figure 8, Figure 10, column 4, lines 26-36, column 12, line 63 to column 14, line 9). Further, Trudeau's invention "provide[s] the user with readily available tools to achieve disciplinary control over behavior which is out of control... hinged upon a routine comprising a work schedule of activities done in the morning, during the day and at night... [enabling] ... the individual ... [....] ... by following a relatively rigid set of procedures ... [enabling]... them to break the pattern ... [....]... often characterizing dependents and co-dependents... [and]... convey[ing] through various workshops specific information assisting the individual in surmounting denial with exercises, knowledge and feeling" (Trudeau; column 13, lines 25-47). Trudeau also teaches "the user can establish a program for each of the portions of the day: morning, day-time and night" and "the user might schedule one of a plurality of workshops" (Trudeau; column 13, lines 51-61). As such, the Examiner respectfully submits that "selecting suitable times for scheduling said plurality of tasks in view of said current health parameters and designated allowances for said particular user at said personal health monitoring system, such that said personal health monitoring system aids said particular user in scheduling tasks in order to balance the comprehensive health of said particular user" is taught by the applied references.


As such, it is unclear as to how or why Appellant's claimed limitations are not met by at least the aforementioned passages. Perhaps Appellant is relying on features not expressly recited in the claims, but disclosed in the specification. However it has been held that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Consequently, it is respectfully submitted that contrary to Appellant's allegations, the features that Appellant disputes are clearly within the teachings of the applied references and that Appellant fails to properly consider the clear and unmistakable teachings of the applied references, as illustrated above.

Thus, in light of the reasons and responses given above, it is respectfully submitted that a *prima facie* case of obviousness has been clearly established by the Examiner.

Art Unit: 3626

For the above reasons, it is believed that the rejections should be sustained.

  
JOSEPH THOMAS  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 3600


Respectfully submitted,

Natalie Pass  
Examiner  
Art Unit 3626

  
NP

January 12, 2004

Conferees

JOSEPH THOMAS   
Supervisory Patent Examiner  
Tech Center 3600

ERIC STAMBER   
Supervisory Patent Examiner  
Tech Center 3600

FOLEY AND LARDNER  
SUITE 500  
3000 K STREET NW  
WASHINGTON, DC 20007